

### REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed December 14, 2004.

Currently, claims 1- 39, and 41-51 are pending. Applicants have clarified claims 1, 9, 28, and 35. Applicants respectfully request reconsideration of claims 1-39, and 41-51.

#### Rejection of Claims 1-4, 7-11, 15-21, and 28 under 35 U.S.C. § 102(b)

Claims 1-4, 7-11, 15-21, and 28 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,761,674 to Ito ("Ito"). Applicants have clarified claims 1, 9, 28, & 35 and respectfully submit that claims 1-4, 7-11, 15-21, and 28 are in condition for allowance.

Ito teaches an integrated construction project information management system which relates to a method of viewing information contained in a database. Ito teaches that a project model is composed of a product model and a process model. (Ito Col. 2, Lines 10-15). As defined below Ito's product model and process model relate to the views and hierarchically arranged objects. Ito discloses:

Accordingly, the present invention provides an integrated construction project information management system which includes a project model constructed by combining together a product model that defines a product by using physical elements and functional elements, and a process model that defines activities related to the product. Such process model includes elements which are described as hierarchical objects in the form of views arranged along the flow of productive activities; interfaces between the project model on the one hand and other systems and a database on the other; and a user interface. (Ito Col. 2, Lines 5-15).

Ito teaches that various industry systems such as CAD systems have been developed and that part of such systems is a user interface. Ito discloses:

Under the above-described circumstances, various computer systems (e.g., CAD system, analytical system, analytical system, simulation system, etc.) have been developed and introduced by construction firms. However, many of these systems are

effective only within a very narrow application domain so that transmission of information between different domains is realized by linking together the applications in the current state of art. Accordingly, exchange of project data between persons engaged in activities in different domains cannot be accomplished in a satisfactory manner based on the teachings of the prior art. (Ito Col. 1, Lines 46-57).

Each of claims 1-4, 7-11, 15-21, and 28 define at least the elements of

- (a) at least a first item specification template for collecting information from a user defining a plurality of data fields for an item.

The present invention recites the limitation “a first item specification template.” The examiner has stated that the first item specification template disclosed by the applicants is anticipated by the product model disclosed by Ito. Applicants have clarified this element of the claims, and the applicants respectfully submit that Ito does not disclose a first item specification template. The examiner has indicated that a “project model” anticipates a first item specification. Applicants respectfully point out that the claims do not recite a project model, a product model, or a process model. The claims recite “at least a first item specification template” as defined in the specification. In making the rejection the examiner has cited language from Ito in arguing that CAD systems meet this limitation. Ito discloses:

In addition, if a designer defines data concerned with a project by using CAD, a product model in the project model can be automatically formed with information obtained from CAD. An interface therefore is also restrictively provided for CAD. Other applications also have their own interfaces. For example, even a simple system for estimating has an interface as long as it is a system concerned with sales information. By obtaining data through such interfaces, the model increases as the project progresses; and data related to the project is stored. When a person in charge wants to see information given at a later stage, all the information can be drawn from the model. Thus, all information concerned with the project is unitarily or cumulatively managed by this model. (Ito, Col. 4, Lines 43-48).

The applicants assert that the recited item specification template is not anticipated by a CAD interface well known to the art. One embodiment although by no means the only embodiment of the present invention is described below. The applicants disclose:

Specifications are used throughout the life of a project from design, through procurement, execution and asset tracking. Almost all users of the system shown in the cop-pending application will have access to the Specification in some capacity. CAD users can associate Specification to drawing objects; a purchasing agent can access the uploaded counts from CAD to determine how many are required and the Project Manager can monitor progress and the budget. (Specification, Page 14, Lines 16-26).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Based on the above, it is respectfully submitted that Claims 1-4, 7-11, 15-21, and 28 are not disclosed in Ito, and it is respectfully requested that the rejection of these claims on Section 102 grounds be withdrawn.

Rejection of Claims 5, 6, 12, 13, 22-25, 27, 30-35, 37, 38, and 41-51 under 35 U.S.C. 103(a)

Claims 5, 6, 12, 13, 22-25, 27, 30-35, 37, 38, and 41-51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito as applied to claims 1-4, 7-11, 15-21, and 28 and further in view of U.S. Patent 5,950,206 to Krause (“Krause”).

Initially, the applicants respectfully submit that the Examiner has provided no guidance as to why a person having ordinary skill in the art would have combined Ito with Krause. Applicants respectfully submit that no teaching or suggestion is found in the reference or in the prior art in general to make this combination. MPEP § 2145 Subsection X Paragraph C summarizes the standard which the examiner must abide by in setting forth an obviousness rejection.

As discussed in MPEP § 2143.01, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references, as discussed in the aforementioned section.

Specifically, “it is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements.” *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). The examiner must show the additional step of how this knowledge of the skilled artisan leads to the suggestion or motivation.

The above notwithstanding, even were the references to be combined, the combined teachings still do not render the claimed invention obvious. Each of Claims 5, 6, 12, 13, 22-25, 27, 30-35, 37, 38, and 41-51 contains the limitation at least a first item specification template for collecting information from a user defining a plurality of data fields for an item. Krause teaches a method and apparatus for searching and tracking construction projects in a document information database. Ito teaches an integrated construction project information management system. Specifically, Krause teaches an apparatus, i.e. a computer with peripherals that is optionally connected to a main server that can search through a database and look up construction projects. Krause teaches that this is done through a database stored on either a local computer or a remote server.

The applicants claimed invention is are not contained within the cited references. The Applicants disclose:

In general, data is created in the database by the design toolset applications. Data is stored in the system in the form of “intelligent objects.” When actions (budgeting, purchasing, delivering, maintenance scheduling) occur to that object, by any system user, the “intelligence of the object is updated with this information. (Specification Page 22, Lines 21-25)

While this is only one feature of many novel advances presented by the applicants in their present application, neither Krause nor Ito teach or suggest anything of this nature. Generally, Krause and Ito have not contributed in any way to this area of this art.

Krause does not in even any broad reading of the claims teach or suggest an item specification object management system. The item specification template, as discussed above is related to all aspects of the project form design. The examiner has not cited Krause as having disclosed the item

specification template, however, the examiner has cited a number of other limitations found in applicants' dependent claims which relate to object specifications and are not disclosed by Krause or Ito. At the minimum, neither Krause nor Ito disclose an item specification template, configurable data object, an item specification creation wizard, an item specification creation tool, an item specification manager as these are defined by the applicants.

The applicants assert that these advanced new methods taught by the applicants are nowhere taught, disclosed, or suggested by Krause and Ito. For these reasons, it is respectfully requested that the rejections of claims 5, 6, 12, 13, 22-25, 27, 30-35, 37, 38, and 41-51 on section 103 grounds be withdrawn.

Rejection of Claims 14, 26, 29, and 36 under 35 U.S.C. 103(a)

Claims 14, 26, 29, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito in view of Krause further in view of US Patent 6,063,128 to Bentley ("Bentley"). Bentley teaches an object oriented computerized modeling system, and the examiner has cited the reference to reject the limitation "wherein the network is the internet." Claims 14, 26, 29, and 36 contain the elements of their respective base independent claims. As discussed above, neither Ito nor Krause disclose the elements of the independent claims. Bentley does not add to the teachings of Krause or Ito in this regard. The applicants assert that as above, Ito, Krause and Bentley do not teach or suggest all of the elements of claims 14, 26, 29, and 36 whether separately or in combination.

Based on the above amendments and these remarks, reconsideration of claims 1-39, 41-51 is respectfully requested.

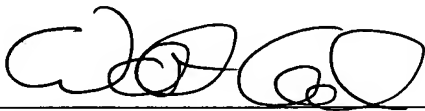
The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned agent by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, June 14, 2005.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 6/14/05

By:   
Walter K. Coronel  
Reg. No. 56,177

VIERRA MAGEN MARCUS HARMON & DENIRO LLP  
685 Market Street, Suite 540  
San Francisco, California 94105-4206  
Telephone: (415) 369-9660  
Facsimile: (415) 369-9665